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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Andrea Waxler
Serial No. : 09/648,473
Filed : August 25, 2000
Title : WORK SHARING AND COMMUNICATING

Art Unit : 2154
Examiner : Nabil El-Hady

Mail Stop Appeal Brief - Patents

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

(i) *Real Party in Interest.*

Practicefirst.com L.L.C.

(ii) *Related Appeals and Interferences.*

None.

(iii) *Status of Claims.*

Claims 1-3 and 9-13 being appealed stand rejected under 35 U.S.C. § 102(b) as anticipated by Christy U.S. Pat. No. 6,182,117, claims 4-8 being appealed stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Christy as a primary reference in view of Schwartz U.S. Pat. No. 6,236,994 as a secondary reference, and claim 14 being appealed stands rejected under 35 U.S.C. § 102(b) as being anticipated by Hunnincet U.S. Pat. No. 5,889,952.

(iv) *Status of Amendments.*

None.

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(v) *Summary of Claimed Subject Matter.*

The invention relates to work sharing and communicating over the internet with a web-site system that includes at least a communication component allowing users in professional offices to electronically input data over the internet including electronically storing the data received over the internet in the data storage component of the web-site system, such as 31, automatically determining to which other related portions of the web-site system electronically stored data will be sent, such as 24, automatically distributing the electronically restored data to the automatically determined other related portions of the web-site system, such as 30, electronically storing the data distributed to the other related portions of the web-site system in the data storage component, such as 31, and automatically communicating over the internet to other relevant users on the newly stored data in the web-site system, such as page 1, line 21-page 2, line 18.

The apparatus for work sharing and communicating may include a computer and a web-site system that includes at least a communication component and a data storage component allowing users in professional offices to electronically input data over the internet, a data storage device for electronically storing the data electronically inputted into the web-site system, a source of a computer program for automatically determining to which other related portions of the web-site system the electronically stored data will be sent, a source of a computer program for automatically distributing the electronically stored data to the automatically determined other related portions of the web-site system a data storage device for electronically storing the data distributed to the other related portions of the web-site system and a source of a computer program for automatically communicating over the internet to other relevant users of the newly stored data in the web-site system. Page 2, line 19-page 4, line 6. This method for enrolling and grouping users in professional offices includes assigning enrolled users into specific work groups, assigning the specific work groups levels of access to a web-site system over the internet, limiting the specific work group to the assigned level of access to the web-site system and providing communication capabilities over the internet to the specific work groups which are limited to the work groups assigned levels of access. Page 3, line-19-page 4, line 6.

(vi) Grounds of Rejection to be reviewed on appeal.

1. Whether claims 1-3 and 9-13 are anticipated under 35 U.S.C. §102(b) by Christy when the reference fails to disclose each and every element in each claim arranged as in the claim.
2. Whether 4-8 are unpatentable over Christy as a primary reference in view of Schwartz as a secondary reference when the references fail to suggest the desirability of combining what is there disclosed to meet the terms of these claims.
3. Whether claim 14 is anticipated under 35 U.S.C. §102(b) as anticipated by Honeycutt when the reference fails to disclose each and every element in the claim arranged as in the claim.

(vii) Argument.

I. CLAIMS 1-3 AND 9-13 ARE NOT ANTICIPATED BY CHRISTY BECAUSE THE REFERENCE FAILS TO DISCLOSE EACH AND EVERY ELEMENT IN THESE CLAIMS ARRANGED AS IN THE CLAIM.

Claims 1-3, and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Christie et al. (US 6,182,117).

As to claim 1, Christie discloses the invention as claimed including a method of work sharing and communicating over the Internet with a web site system (abstract; and col. 8, lines 5-13) that includes at least a communication component and a data storage component (Fig. 2B; and col. 9, lines 10-50) allowing users to electronically input data over the internet (Fig. 2B) comprising: electronically storing the data received over the internet in the data storage component of the web site system (col. 3, lines 24-25; 210, 220, Fig. 2B); automatically determining to which other related portions of the web site system the electronically stored data will be sent (col. 4, lines 22-24); automatically distributing the electronically stored data to the automatically determined other related portions of the web site system (col. 4, lines 24-27); electronically storing the data distributed to the other related portions of the web site system in the data storage component (col. 4, lines 41-45); and automatically communicating over the internet to other relevant users of the newly stored data in the web site system (col. 4, lines 24-27).

As to claim 11, the claim is rejected for the same reasons as claim 1 above. In addition, Christie discloses an apparatus for work sharing and communicating

comprising a computer at a web site system that includes at least a communication component and a data storage component allowing users in professional offices to electronically input data over the internet (Fig. 2B).

As to claim 2, Christie discloses said automatically determining is controlled by a computer program programmed to determine which portions of

the web site system the electronically stored data will be sent (col. 9, line 66 to col. 10, line 20).

As to claim 3, Christie discloses the computer program controls determining to which portions of the web site system the electronically stored data is relevant, and enacts the automatic distribution to distribute the electronically stored data accordingly (col. 9, line 66 to col. 10, line 20).

As to claim 9, Christie discloses the electronic storage occurs on a remote data processing machine that can be accessed from remote terminals via a channel from the group consisting of the Internet and an intranet (Fig. 2B; and col. 8, lines 46-51).

As to claim 10, Christie discloses the automatic distributing is controlled by a computer program programmed to distribute the electronically stored data to the automatically determined portions of the web site system (col. 9, line 66 to col. 10, line 20).

As to claim 12, Christie discloses the web site system includes terminals intercoupled to the computer by a link (Fig. 2B; and col. 9, lines 16-25).

As to claim 13, Christie discloses the data storage comprises data storage device that stores the first input data and a data storage device that stores the data distributed to the other related portions of the web site system (col. 3, lines 24-31). Pp.3-4.

...

As to point (1), a website is known to comprise a group of related HTML documents and associated files, scripts, and databases that is served by a server on the world wide web. Large organizations / enterprises would have one or more servers dedicated to a single website, each server, which may resemble a team or a department, may represent a portion of the website, and are communicating with each other through a network. The computer sites of Christie represent one or more servers dedicated to group interaction through workgroup applications, and anticipates the one or more server dedicated to a single website (see, Christie, col. 1, lines 24-50). Server 100 of Hunnicut represents an enterprise server where the enterprise resource (e.g. website) would reside. Enrolling users into workgroups and assigning a specific workgroup level of access to the server resource, anticipate assigning a specific workgroup levels of access to the enterprise website on server 100 (see Hunnicut, col. 7, lines 38-62). P.7

“Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

“This court has repeatedly stated that the defense of lack of novelty (i.e., ‘anticipation’) can only be established by a single prior art reference which discloses each and every element of

the claimed invention.” *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including Connell.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from Connell, “Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim,” 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term “engaging the ball” recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, “Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim.” *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

All these rejected claims call for a method of work sharing and communicating over the internet with a website system, electronically storing the data received over the internet in the data storage component of the website system, automatically determining to which other related

portions of the website system the electronically stored data will be sent, automatically distributing the electronically stored data to the automatically determined other related portions of the website system, electronically storing the data distributed to the other related portions of the website system in the data storage component and automatically communicating over the internet to other relevant users of the newly stored data in the website system. Parent claim 1 recites website 6 times. A website is a set of interconnected pages, usually including a home page, generally located on the same server, and prepared and maintained as a collection of information by a person, group, or organization. At least because the reference does not disclose a website, it cannot anticipate any of the rejected claims.

If this ground of rejection was repeated, the Examiner was respectfully requested to identify the column and line where the reference discloses a website as distinguished from the disclosed computer sites. The Examiner did not and can not comply with this request.

II. CLAIMS 4-8 ARE PATENTABLE OVER CHRISTY AS A PRIMARY REFERENCE AND SCHWARTZ AS A SECONDARY REFERENCE UNDER 35 U.S.C. §103(A) BECAUSE THE REFERENCES FAIL TO SUGGEST THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF THESE CLAIMS.

The final action states:

Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christie et al. (US 6,182,117) in view of Swartz et al. (US 6,236,994).

As to claim 4, Christie does not necessarily disclose a portion of a knowledge-management system. Swartz, on the other hand, discloses a portion of a knowledge-management system in an information sharing and communicating system (col. 4, lines 12-15). It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Christie and Swartz because Swartz knowledge-management system would enhance the functionality of Christie's system by permitting an efficient establishment and use of a knowledge repository in an organization or enterprise that reflects the collective learning of the individuals, shared groups, and systems employed by the organization (see Swartz, col. 5, lines 30-35, and col. 6, lines 8-10).

As to claim 5-8, Swartz discloses the need for the knowledge-management system for a wide range of industries (col. 1, lines 33-54). It would have been obvious to one skilled in the art at the time of the invention that a service industry would also need knowledge-management system for the same obvious reasons of enhancing the prospects of the industry by permitting an efficient establishment and use of a knowledge repository within the industry that reflects the collective

learning of the individuals, shared groups, and systems employed by the industry (see Swartz, col. 5, lines 30-35, and col. 6, lines 8-10). It would have been obvious too to one skilled in the art at the time of the invention that a service industry would be covering group of a medical practice, hospital, and a medical health maintenance organization, a group consisting of a law office, law firm, courthouse, and a legal business entity, or a group consisting of an accounting firm, tax firm, temporary employment firm, financial and employment business entity. Pp.5-6.

...

As to point (2), Swartz advances the concept of maintaining knowledge in an organizational or enterprise sense that may be reflected in a digital electronic format in a knowledge repository (e.g. website) that is suitable for the receipt or recording the knowledge of any portion of the enterprise (see, Swartz, col. 6, lines 8-16). As such, Swartz employs a knowledge-management system (col. 4, lines 12-15).

As Christie does not disclose the employment of a knowledge-management system, it would have been obvious to one skilled in the art at the time of the invention to modify the teaching of Christie and combining to it Swartz's knowledge-management system. The obvious motivation for that is presented by Swartz himself in col. 5, lines 30-35, and col. 6, lines 8-10. A knowledge-management system would enhance the functionality of Christie's system by permitting an efficient establishment and use of a knowledge repository in an organization or enterprise (e.g. their website) that reflects the collective learning of the individuals, shared groups, and systems employed by the organization. Pp.7-8.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.” *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

“The critical inquiry is whether ‘there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. [citing Lindemann with emphasis added.]’” *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in

the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." Ex parte Schwarz, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." Ex Parte Kusko, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the references to meet the terms of claims 5-8 is reason enough for withdrawing the rejection of them.

If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in the references regarded as corresponding to each element in these rejected claims and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of these claims.

The Examiner did not and can not comply with this request.

III. CLAIM 14 IS NOT ANTICIPATED BY HONEYCUTT UNDER 35 U.S.C. §102(B) BECAUSE THE REFERENCE FAILS TO DISCLOSE EACH AND EVERY ELEMENT IN CLAIM 14 ARRANGED AS IN THE CLAIM.

The final action states:

As to claim 14, Hunnincut discloses the invention as claimed including a method for enrolling and grouping users in professional offices comprising assigning enrolled users into specific work groups (inherent in col. 7, lines 38-40); assigning the specific work groups levels of access to a web site system over the internet (inherent in col. 7, lines 40-62); limiting the specific work group to the assigned level of access to the web site system (col. 7, lines 59-62; and Fig. 5); and providing communication capabilities over the internet to the specific work groups which are limited to the work groups assigned level of access (inherent in col. 7, lines 50-55). P.6.

Like the Christie and Swartz patents, the Hunnincut patent fails to disclose a website. Accordingly, the reference cannot anticipate claim 14 which calls for, inter alia, assigning the specific work groups levels of access to a website system over the internet and limiting the specific work group to the assigned level of access to the website system. Accordingly, withdrawal of the rejection of claim 14 as anticipated by Hunnincut was respectfully requested. Should this ground of rejection be maintained, the Examiner was respectfully requested to

identify the column and line in the reference where a website is disclosed. The Examiner did not and can not comply with this request.


CONCLUSION

In view of the forgoing authorities and remarks and the inability of the prior art alone or in combination to anticipate, suggest or make obvious the invention disclosed and claimed in this application, all the claims are in a condition for allowance, subject to overcoming formal objections to the description, and notice thereof is respectfully requested. Should the Board believe that one or more claims are allowable in amended form, the Board is respectfully requested to include an explicit statement to that effect and direct entry of such amendments in the absence of new prior art or grounds of rejection.

The brief fee of \$250 is enclosed. Please apply any other charges or credits to Deposit Account No. 06-1050, Order No. 11790-003001.

Respectfully submitted,
FISH & RICHARDSON P.C.

Date: DEC 27 2004



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(viii) Claim Appendix.

1. A method of work sharing and communicating over the internet with a web site system that includes at least a communication component and a data storage component allowing users in professional offices to electronically input data over the internet comprising,

electronically storing the data received over the internet in the data storage component of the web site system;

automatically determining to which other related portions of the web site system the electronically stored data will be sent;

automatically distributing the electronically stored data to the automatically determined other related portions of the web site system;

electronically storing the data distributed to the other related portions of the web site system in the data storage component; and

automatically communicating over the internet to other relevant users of the newly stored data in the web site system.

2. The method of claim 1, wherein said automatically determining is controlled by a computer program programmed to determine which portions of the web site system the electronically stored data will be sent.

3. The method of claim 2, wherein the computer program controls determining to which portions of the web site system the electronically stored data is relevant, and enacts the automatic distribution to distribute the electronically stored data accordingly.

4. The method of claim 3 wherein the portions of the web site system further comprise portions of a knowledge-management system.

5. The method of claim 4 wherein the knowledge-management system further comprises a service industry knowledge management system.

6. The method of claim 5, wherein the service industry is from the group consisting of a medical practice, hospital, and a medical health maintenance organization.

7. The method of claim 5, wherein the service industry is from the group consisting of a law office, law firm, courthouse, and a legal business entity.

8. The method of claim 5, wherein the service industry is from the group consisting of an accounting firm, tax firm, temporary employment firm, financial and employment business entity.

9. The method of claim 1, wherein the electronic storage occurs on a remote data processing machine that can be accessed from remote terminals via a channel from the group consisting of the internet and an intranet.

10. The method of claim 1, wherein the automatic distributing is controlled by a computer program programmed to distribute the electronically stored data to the automatically determined portions of the web site system.

11. An apparatus for work sharing and communicating comprising:

a computer at a web site system that includes at least a communication component and a data storage component allowing users in professional offices to electronically input data over the internet;

a data storage device for electronically storing the data electronically inputted into the web site system;

a source of a computer program for automatically determining to which other related portions of the web site system the electronically stored data will be sent;

a source of a computer program for automatically distributing the electronically stored data to the automatically determined other related portions of the web site system;

a data storage device for electronically storing the data distributed to the other related portions of the web site system; and

a source of a computer program for automatically communicating over the internet to other relevant users of the newly stored data in the web site system.

12. The apparatus of claim 11, wherein the web site system includes terminals intercoupled to the computer by a link.

13. The apparatus of claim 11 wherein the data storage comprises data storage device that stores the first input data and a data storage device that stores the data distributed to the other related portions of the web site system.

14. A method for enrolling and grouping users in professional offices comprising:
assigning enrolled users into specific work groups;
assigning the specific work groups levels of access to a web site system over the internet;
limiting the specific work group to the assigned level of access to the web site system; and
providing communication capabilities over the internet to the specific work groups which are limited to the work groups assigned level of access.

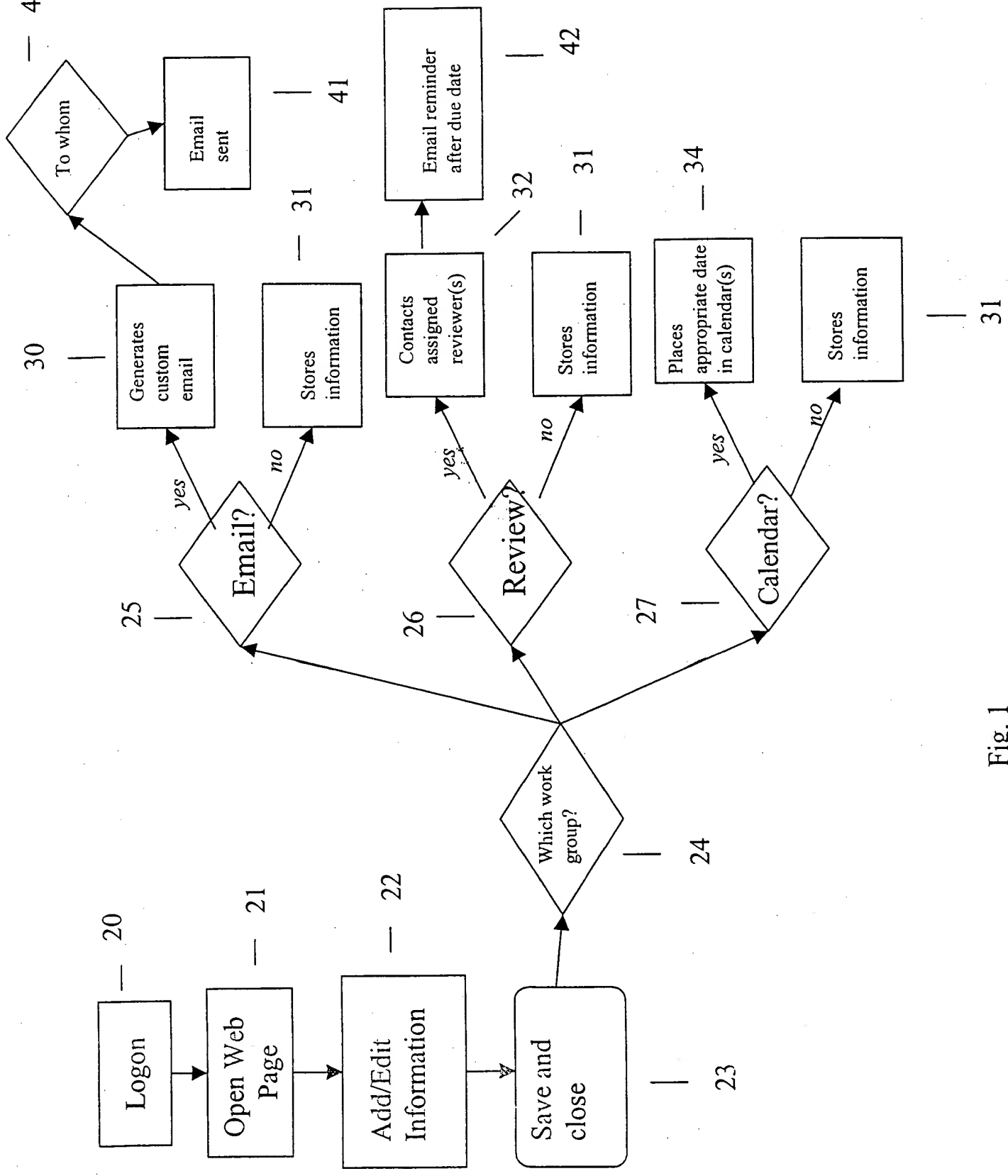


Fig. 1

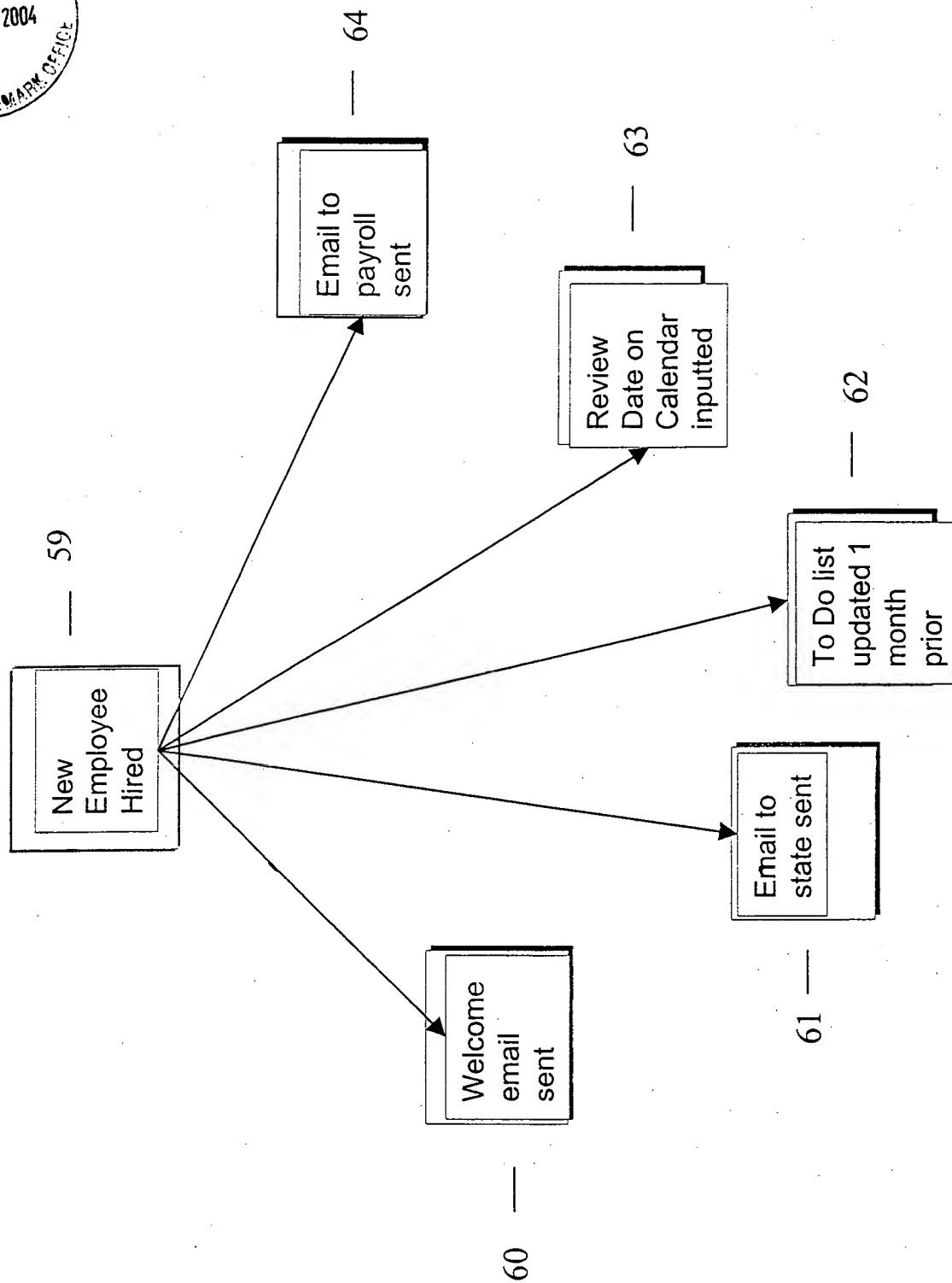


Fig. 2